

AMENDMENTS TO THE DRAWINGS:

Applicant submits with this amendment drawing Replacement Sheet 2/2 and respectfully requests that it be entered and substituted for drawing Sheet 2/2 originally filed with the application. Replacement Sheet 2/2 includes revised Figs. 6, 8, and 10 that correct all of the part numbering objections noted by the examiner. No other changes have been made to the drawings. No new matter has been introduced.

REMARKS

Claims 40, 45, and 50 have been amended and claims 41, 46, and 51 canceled in this paper. Claims 40, 42 - 45, 47 - 50, 52 - 53 are pending after entry of this amendment.

The examiner objected to the drawings based on some informalities in the part numbers. Applicant submits with this amendment drawing Replacement Sheet 2/2 and respectfully requests that it be entered and substituted for drawing Sheet 2/2 originally filed with the application. Replacement Sheet 2/2 includes revised Figs. 6, 8, and 10 that correct all of the part numbering objections noted by the examiner. No other changes have been made to the drawings.

The examiner rejected claims 40, 43 - 45, 47 - 50, 52 and 53 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,666,968 (Imran et al.) This rejection is respectfully traversed.

Independent claims 40, 45 and 50 have been amended to provide that the weld “does not include a filler material.” This limitation was based on now canceled dependent claims 41, 46, and 51. As acknowledged by the examiner on page 5 of the Office action, Imran fails to disclose or teach a weld that does not include filler material. At least for this reason, amended claims 40, 45, and 50 are patentable over Imran.

The examiner rejected claims 41, 42, 46 and 51 under 35 U.S.C. § 103(a) over Imran '968 as applied to claims 40, 45 and 50, and further in view of U.S. Patent No. 6,193,706 (Thorud et al.) This rejection is respectfully traversed.

According to the examiner, Thorud discloses a guide wire extension system and a weld that does not include filler material. The examiner then attempts to combine the teachings of Imran and Thorud. Applicant respectfully contends that the examiner has not established *prima facie* obviousness since, even if the references were properly combinable, the Imran/Thorud guide wire has a weld joint that still has a sleeve covering the weld. All independent claims specify that “the joint is not covered by a sleeve.”

As seen in FIG. 4 and described in col. 10, lines 8-10 of Thorud, the weld joint 32 is located at the interface between the elongated shaft 24 and a hollow tubular body 30 (i.e., a sleeve). The sleeve 30 is part of a female coupler segment 26 that receives a male connector segment 15 as shown in FIG. 1 of Thorud. Accordingly, if the teachings of Imran were modified by Thorud, the embodiment of Imran to be modified must be the embodiment shown in FIG. 2 of Imran that uses a sleeve to cover the weld, as in FIG. 4 of Thorud that also uses a sleeve 30.

There is no teaching or suggestion in Thorud that the weld with no filler material 32 can be used to join the shaft 24 of the extension wire 12 to the male connector segment 15, because as seen in FIG. 2 of Thorud, there is a gap between the two wire ends so a resistance weld, spot weld, etc., is not possible. It follows then that if the Thorud teaching is used to modify the Imran guide wire, then it must be the FIG. 2 Imran embodiment with a gap between the guide wire ends 33, 17 and covered by a sleeve 46 that is modified.

Finally, Imran in col. 3, ll. 56-59 describes a “solder joint or weld,” but does not suggest a weld without a filler material, because the junction requires a gap as seen in both embodiments of FIGS. 2 and 3 of Imran (in order to receive the filler material of the weld or solder). There is no motivation then in Imran -- which only contemplates gapped joints -- to look for a gapless joint that can be joined by a weld without filler material as taught in Thorud. It was therefore improper to combine the references and the examiner has not established *prima facie* obviousness.

On the other hand, the examiner states on page 5 of the Office action that the general motivation to modify the Imran FIG. 3 embodiment with Thorud is that both relate to “means for welding guidewire sections together.” However, if the FIG. 3 embodiment of Imran were modified with the FIG. 4 resistance or spot weld 32 embodiment of Thorud, the resulting joint still has a sleeve 30 covering the weld 32 (as in Thorud), as applicant noted above. If the FIG. 3 Imran embodiment is modified with the FIG. 4 Thorud embodiment and it were proper to omit the Thorud sleeve 32, there is still

no predictability that the weld 32 of Thorud would hold and not fail in the Imran FIG. 3 embodiment without the sleeve for support. Again, there is still no *prima facie* obviousness since the claims preclude a sleeve covering the joint, and if the Imran/Thorud joint omits the sleeve, the references lack teachings to give any predictability in the outcome.

Because the references lack any motivation or desirability to combine, applicant respectfully submits that the examiner used applicant's own teachings as the source of motivation to modify the FIG. 3 Imran gapped-and-filler-material weld joint with the Thorud no-gap, fillerless weld. Thus, applicant contends that this obviousness rejection is based on impermissible hindsight and should be withdrawn. At least for all of the foregoing reasons, the present invention as defined by the claims is not obvious in view of the references individually or in combination.

In view of the foregoing, applicant respectfully submits that all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. The Commissioner is authorized to charge Deposit Account number 06-2425 for any unforeseen additional fees arising from the filing of this paper.

Respectfully submitted,
FULWIDER PATTON LLP

By: Paul Y. Feng
Paul Y. Feng
Registration No. 35,510

PYF:gbr

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, California 90045
Telephone: (310) 824-5555
Fax: (310) 824-9696
Customer No. 24201